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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,202	04/12/2004	Daniel Simmons JR.		2107
7590	12/16/2004		EXAMINER	
International Plant Management, Inc.			HAAS, WENDY C	
55826 60th Avenue				
Lawrence, MI 49064			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/822,202	SIMMONS ET AL.
	Examiner	Art Unit
	Wendy C Haas	1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 April 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### *Oath/Declaration*

A new oath or declaration is required because applicant has not asserted that the claimed plant was found in a cultivated area. 37 CFR 1.162 requires that the declaration in an application for patent on a found plant must state that the plant was found in a cultivated area. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

### *Objection to the Disclosure*

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

#### **35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same *per se* and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. The Specification is not in the proper format. A new, substitute Specification, properly formatted, will be required. The Specification should be double-spaced and should have line numbers printed every five (5) lines in the margin. The proper format and headings for the Specification are set forth in Chapter 1600 of the MPEP (Manual of Patent Examining Procedure), which can be found online at <http://www.uspto.gov/web/offices/pac/mpep/mpep.htm>

The proper format is as follows (from 37 CFR 1.163(c), set forth in MPEP § 1605):

(1) TITLE

(2) CROSS-REFERENCE TO RELATED APPLICATIONS (If applicable)

(3) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR  
DEVELOPMENT (If applicable)

(4) BOTANICAL DESIGNATION

(5) VARIETY DENOMINATION

(6) BACKGROUND OF THE INVENTION

(7) BRIEF SUMMARY OF THE INVENTION

(8) BRIEF DESCRIPTION OF THE DRAWING

(9) DETAILED BOTANICAL DESCRIPTION

(10) A SINGLE CLAIM

(11) ABSTRACT OF THE DISCLOSURE

37 CFR 1.163(d) notes: “The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.” Correction is needed.

B. Applicants do not make the origin of the claimed tree clear in the specification.

Applicant state “originating as a whole tree mutation of . . . ‘Arends’.” It is unclear how a whole tree mutation would originate. Was the claimed plant found in a cultivated area where clones of ‘Arends’ had been planted? Is the claimed plant a budded scion from an ‘Arends’ tree that developed with different characteristics (i.e. a bud-sport)? Clarification is needed.

C. Page 1, applicants recite: “(U.S. Plant Patent 2,800).” This, and other similar recitations should be amended to read: -- (United States Plant Patent Number 2,800)--.

D. Page 1, line 16, the recitation – in a cultivated area – should be added after the word “discovered”, if accurate. The claimed plant must be discovered in a cultivated area in order for it to qualify for patent protection under 35 U.S.C. § 161.

E. Page 1, lines 17 and 18, applicants should amend these lines to indicate that the buds were taken from the initial tree of the new variety and other clonal individuals of the claimed variety, if accurate, or otherwise clarify this confusing recitation.

F. Applicants may not advertise specific businesses in the United States Patent; Applicant should amend line 18 of page 1 to read – were asexually produced by [insert propagation method] in Brentwood, CA.—

G. Page 2, applicants specify that the claimed plant has been reproduced on several rootstocks; applicants should specify the method used (i.e. budding, whip-grafting, etc.).

H. Applicants must provide and describe a photograph of the entire tree, showing trunk, branches and habit and a photograph of the flowers of the tree (or a single photograph of the entire tree in bloom).

I. Applicants should change the words FIG. 1 to read: --The drawing--. As the drawing sheet of record is not so labeled, it is inappropriate to refer to the drawing as FIG. 1 in the specification. The specification and drawing must correspond to each other in this regard.

J. Applicants are encouraged to proofread the specification for errors in spelling and grammar and to correct same.

K. Page 2, applicants should provide the age of the plant as described in the “BOTANICAL DESCRIPTION OF THE PLANT” as well as the rootstock the described plant was grown on (or own roots, if appropriate) and the typical and observed climatic conditions in the location of culture.

L. Page 2, applicant may delete the Classification information. The Examiner will classify the subject matter of the application and ensure the appropriate class is printed on any publication and/or patent that may issue.

M. Page 2, applicants should remove references to "Peace Valley Orchards" and refer only to "Rogers, Ohio".

N. Page 2, applicants describe the Size of the Tree as "12 in height". Applicants must specify units (i.e. meters, feet, etc.) in order to lend this recitation substantive meaning. The Examiner notes that both meters and feet are cited as units in the Specification.

O. Page 3, applicants must provide the leaf bud size (length and width or diameter), color with reference to the employed color chart and botanical shape in order to provide as complete a botanical description as is reasonably possible.

P. Page 3, applicants must provide the lenticel size (length and width), if available, as well as the typical and observed concentration of lenticels per unit area (e.g. about 9 per square inch, or similar) in order to provide as complete a botanical description as is reasonably possible.

Q. The disclosure is objected to under 35 U.S.C. 112, first paragraph, because the Abaxial leaf colors specified fail to correspond with those shown. Specifically, the specification recites "Yellow-Green Group 14C." 14C is a bright yellow-orange color in the Yellow-Orange group of the RHS Colour Chart. The abaxial leaf surfaces depicted in the photograph of record appear to be a medium sage green. Correction is required.

R. Applicants must provide the stipule shape, apex shape and margin shape.

S. Page 4, three lines before the bottom, the spelling of "Adaxile" should be corrected.

T. Page 5, applicants must provide more botanical information regarding the flowers of the claimed plant in order to provide as complete a botanical description as is reasonably possible. Specifically, applicants should provide:

Calyx/sepal length, width, shape (including margin shape, apex, base and overall shape, number of sepals and color with reference to the employed color chart.

Flower petal length, width, shape, (including margin shape, apex, base and overall shape, flower diameter, flower depth, whether or not the bloom is showy, and color with reference to the employed color chart.

Information as to the reproductive organs including number of stamens and pistils anther size and color, pistil size and color, ovary color.

Whether or not there are known pollen incompatibilities with the claimed plant.

U. Applicants should provide the fruit weight, percent brix and penetrometer reading.

V. Applicants should provide the stem texture.

W. Applicants should provide further information regarding the shipping quality of the fruit of the claimed plant, if possible.

X. Applicants should specify which other bacterial and fungal diseases the claimed plant is resistant to, if available.

Y. Applicant should specify whether or not there are any known graft incompatibilities with the claimed cultivar.

Z. Applicant should italicize or underline *Malus sylvestris* throughout the Specification and in the Abstract and Claim, as such is the convention in the art.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

***Claim Rejection***

**35 U.S.C. § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

***References Cited***

The cited references disclose the state of the art.

***Substitute Specification***

A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the number and nature of amendments needed in the Specification is large and a substitute specification will be needed to facilitate accurate printing of any patent that may grant..

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If

the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c)

*Comments*

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent. It appears that the assignee is attempting to prosecute this application without the services of registered counsel.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

An assignee of the entire interest may elect to prosecute an application under certain, limited circumstance. Applicants and the assignee are advised to consult the MPEP for any filings, such as a Statement under 37 CFR 3.73(b) that may be required to advance prosecution of the application. Any filing improperly executed WILL NOT be considered by the Examiner, as it is impermissible by law.

***Applicant's Response***

It is called to applicant's attention that if a communication is deposited with the U.S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Commissioner for Patents

PO BOX 1450

Alexandria, VA 22313-1450

on \_\_\_\_\_ (date).

Typed or printed name of person signing this certificate

---

Signature \_\_\_\_\_

Date \_\_\_\_\_

Applicant is advised of the new procedures for amending the specification and claim under 37 CFR § 1.121. The new procedures are mandatory. Information on the new procedures, as well as other changes to the rules of practice, is available on the Internet at:

<http://www.uspto.gov/web/offices/pac/dapp/ola/preognitice/moreinfoamdtprac.htm>.

Amendments not submitted in the proper format WILL NOT be considered.

*Future Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

**KENT BELL**  
**PRIMARY EXAMINER**

